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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,974	01/18/2001	Hnas-Jurgen Schaschke	PSB 2000/01 (8463*1)	7109

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EXAMINER

JIMENEZ, MARC QUEMUEL

ART UNIT	PAPER NUMBER
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3726

DATE MAILED: 12/22/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,974

Applicant(s)

SCHASCHKE, HNAS-JURGEN

Examiner

Marc Jimenez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-41 is/are pending in the application.
- 4a) Of the above claim(s) 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Prosecution Reopened

1. In view of the appeal brief filed on 11/6/03, PROSECUTION IS HEREBY REOPENED.

New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 31-33 and 36** are rejected under 35 U.S.C. 102(b) as being anticipated by Hummel et al. (5,992,317).

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Hummel et al. teach a method of using a roller **9 or 10** comprising a roller core and a roller covering being composed of an elastomer material or elastic plastic material (col. 3, lines 61-62, “the non-stick coating consists of a material which includes a fluorine-containing polymer”; see also claims 5 and 6, in col. 6, lines 7-13, which states “the non-stick coating on the surface of the at least one auxiliary roller contains a fluorine-containing polymer”; the “fluorine-containing polymer” of Hummel et al. is clearly an elastomer material or elastic plastic material) containing fluorinated polyolefin (col. 3, lines 63-64, “at least some proportion of polytetrafluoroethylene (PTFE)”; see also claims 7 and 8 of Hummel et al. at lines 14-19, which states “the non-stick coating on the surface of the at least one auxiliary roller contains polytetrafluoroethylene”; it is noted that PTFE or polytetrafluoroethylene is a fluorinated polyolefin as applicant claims in claim 33) comprising the step of running the roller **9 or 10** in a dampening system **4** (col. 4, line 1) of an offset printing machine (fig. 1 and col. 1, line 6-7).

Regarding claims 32 and 33, the PTFE taught by Hummel et al. is also a fluorocarbon plastic (see applicant’s specification at page 5, lines 4-5 which states “..., the fluorinated polyolefin comprises fluorocarbon plastics, in particular fluorinated ethylene propylene copolymer (FEP) or polytetrafluoroethylene (PTFE)”. Therefore, the PTFE of Hummel et al. is clearly a fluorocarbon plastic).

Regarding claim 36, Hummel et al. teach one layer and the elastic plastic material forms a surface layer.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 34, 35, and 37-41** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hummel et al. in view of Meltz (3,345,942).

Regarding claims 34, 35, and 37, Hummel et al. teach the invention cited, as explained above in the rejection of claim 31, with the exception of having from 0.5 to 25% by weight of the fluorinated polyolefin, the fluorinated polyolefin being applied as a powder or fiber or in the form of a fibrous material, and the elastic plastic material is based on natural or synthetic rubber.

Meltz teach using from 0.5 to 25% by weight of fluorinated polyolefin (col. 1, lines 57-58) and the fluorinated polyolefin is applied as a powder (col. 3, lines 52-53 and col. 5, line 22). Meltz also teach that the fluorinated polyolefin could be mixed with a synthetic rubber (col. 3, lines 48-50).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Hummel et al. with from 0.5 to 25% by weight of the fluorinated polyolefin and the fluorinated polyolefin being applied as a powder, in light of the teachings of Meltz, in order to evenly spread the fluorinated polyolefin. Furthermore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have replaced the fluorine-containing polymer of Hummel et al. (see col. 3, lines 62-63 of Hummel et

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al.) with a synthetic rubber, in light of the teachings of Meltz, in order to provide a coating with evenly dispersed fluorinated polyolefin. It is noted that both Hummel et al. and Meltz recognizes the use of PTFE in the rollers.

Regarding claim 38, Meltz teaches that the synthetic rubber is selected from styrene-butadiene rubber (see col. 4, line 37).

Regarding claim 39, Meltz teaches that the elastomer or elastic plastic material is based on acrylonitrile butadiene rubber (col. 3, line 70).

Regarding claims 40 and 41, Hummel et al./Meltz teach the invention cited, in the rejection of claim 37 above, with the exception of the material being a thermoplastic elastomer or a castable polyurethane system. It is noted however, that thermoplastic elastomer such as thermoplastic polyurethane and castable polyurethane systems are known materials (see for example the MatWeb.com and the Chemical Innovations document). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have substituted the materials of Meltz with either a thermoplastic elastomer or a castable polyurethane because thermoplastic elastomer and castable polyurethane are materials suitable for providing an elastic material. Furthermore, It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have selected the claimed material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

Response to Arguments

6. Applicant's arguments with respect to claims 31-41 have been considered but are moot in view of the new ground(s) of rejection.

Contact Information

7. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information. M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, or fax (703) 872-9301 or by email to CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is **703-306-5965**. The examiner can normally be reached on **Monday-Friday, between 5:30 am- 2:00 pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 308-6789 or (888) 786-0101
Assignment Branch	(703) 308-9723
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Petitions/Special Programs	(703) 305-9285
Terminal Disclaimers	(703) 305-8408
PCT Help Desk	(703) 305-3257

If the information desired is not provided above, or a number has been changed, please call the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	http://www.uspto.gov/

MJ

December 15, 2003



PETER VO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700